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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,664	02/06/2002	Chuan Li	ETI.PMMU.011502	8973
7590	11/04/2003			EXAMINER
Chuan Li				WHITEMAN, BRIAN A
Apt. 158				
7908 Avenida Navidad				
San Diego, CA 92122				
			ART UNIT	PAPER NUMBER
			1635	7

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/068,664	LI, CHUAN
	Examiner Brian Whiteman	Art Unit 1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____ .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) Claim(s) ____ is/are allowed.

6) Claim(s) ____ is/are rejected.

7) Claim(s) ____ is/are objected to.

8) Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. ____ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . 6) Other: ____ .

DETAILED ACTION

Claims 1-15 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a plasmid comprising a replication of origin and a selection marker, classifiable in class 435, subclass 320.1.
- II. Claim 8, drawn to a method of preparing a plasmid using polymerase chain reaction, classifiable in class 435, subclass 91.4.
- III. Claim 9, drawn to a method of preparing a plasmid using restriction digestion, classifiable in class 435, subclass 91.4.
- IV. Claim 11, drawn to a method of using a plasmid in DNA cloning, wherein a step used in the production of the plasmid was linearizing the plasmid by restriction digestion, classifiable in class 424, subclass 93.21, class 435, subclass 91.41, class 514, subclass 44.
- V. Claim 12, drawn to a method of using a plasmid in DNA amplification, wherein a step used in the production of the plasmid was linearizing the plasmid by PCR, classifiable in class 424, subclass 93.21, class 435, subclass 91.41, class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and III and Invention I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as

claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the plasmid in invention I can made by materially different processes as set forth in Invention II and III.

Invention I and Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product in invention I can be used in materially different processes as set forth in Inventions IV and V. In addition, the plasmid taught by Sutcliffe (Nucleic Acids Res. 1978, 5:2721-8) can be used in the methods of Inventions IV and V.

Inventions II and IV and Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different function and different effects. The materials and methods for producing the plasmid in Invention II and IV is different than the materials and methods for producing the plasmid in Invention III and V. The specification does not teach that the inventions are capable of use together. In addition, the different classification of each invention further displays that it would be an undue burden on the examiner to search the entire claimed invention because each group requires a different search.

Claims 6 and 7 link(s) invention II and invention III. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 6 and 7.

Claims 10, 13, 14, and 15 link(s) invention IV and invention V. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 10, 13, 14, and 15.

Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Because these inventions are distinct for the reasons given above and the search required for each Group is not required for any other Group listed above and the search for each group is not co-extensive, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (703) 305-0775. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader, SPE - Art Unit 1635, can be reached at (703) 308-0447.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman
Patent Examiner, Group 1635

Scott D. Priebe
SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER